

1 The opinion in support of the decision being entered today was *not* written
2 for publication and is *not* binding precedent of the Board
3

4 UNITED STATES PATENT AND TRADEMARK OFFICE
5
6

7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
9

10
11 *Ex parte* CHRISTOPHER S. AUTTERSON
12

13
14 Appeal 2007-2111
15 Application 09/921,204¹
16 Technology Center 3700
17

18
19 Decided: August 3, 2007
20

21
22 *Before:* STUART S. LEVY, LINDA E. HORNER, and JOSEPH
23 FISCHETTI, *Administrative Patent Judges.*
24

25 LEVY, *Administrative Patent Judge.*
26

27
28 DECISION ON APPEAL
29

30 STATEMENT OF CASE

31 Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection
32 of claims 1 and 11. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ Application filed August 2, 2001. The real party in interest is Argent
Automotive Systems, Inc.

1 Appellant invented a method of advertising and a shipping/packaging
2 container product. (Specification 3.) The method includes (*id.*) the steps of
3 providing a shipping/packaging container product, such as a
4 carton; providing on a first predetermined area of said
5 shipping/packaging container product a first advertisement of a
6 first party owning said shipping/packaging container product;
7 and providing on a second predetermined area of said
8 shipping/packaging container product a second advertisement
9 of a second party separate and distinct from said first party.
10

11 The container product substantially parallels the method steps.

12 We affirm.

13 Claim 1 is representative of the claimed invention and reads as
14 follows:

15
16 1. A method of advertising, comprising the steps of:
17
18 providing a corrugated or chipboard shipping/packaging
19 carton having an outer surface and an inner surface, said carton
20 having the shape of a rectangular parallelepiped;

21
22 visibly printing directly on a first predetermined area of
23 said outer carton surface of said shipping/packaging carton a
24 first visible advertisement for a first product of a first party
25 owning said shipping/packaging carton;

26
27 visibly printing directly on a second predetermined area
28 of said outer carton surface of said shipping/packaging carton a
29 second visible advertisement for a second product of a second
30 party separate and distinct from said first party, which second
31 product is not contained in or part of said carton;

32
33 said first and second visible advertisements are both
34 visibly printed on said shipping/packaging carton at the same
35 time;

1 said second visible advertisement is visibly printed on
2 said second predetermined area of said shipping/packaging
3 carton which would otherwise be a blank area or void of any
4 visible printed details;

5
6 said second predetermined area is allotted by said first
7 party;

8
9 said second visible advertisement is provided by said
10 second party to said first party without said first party buying
11 said second visible advertisement;

12
13 said first party determines the size and location of said
14 second visible advertisement on said shipping/packaging
15 carton;

16
17 said second visible advertisement is visibly printed in
18 said otherwise blank area on a front, back, side, top or bottom
19 of said shipping/packaging carton; and

20
21 the size of said second visible advertisement is determined, at
22 least in part, by the shipping/packaging carton size.

23
24 The Examiner rejected claims 1 and 11 under 35 U.S.C. § 103(a)
25 (2004) as being unpatentable over Ford in view of Zimmerman and
26 Jenniches.

27 The Examiner has also rejected claim 11 as being unpatentable over
28 Kapp in view of Zimmerman.

29 The prior art relied upon by the Examiner in rejecting the claims on
30 appeal is:

31	Ford	US 2,054,596	Sep. 15, 1936
32	Zimmerman	US 2,362,181	Nov. 07, 1944
33	Jenniches	DE 27 23 357 A1	Nov. 30, 1978
34	Kapp	US 5,246,161	Sep. 21, 1993

1 We begin with the rejection of claims 1 and 11 under 35 U.S.C.
2 § 103(a) as being unpatentable over Ford in view of Zimmerman and
3 Jenniches. We turn first to claim 1.

4 The Examiner contends that the shipping/packaging carton of Ford is
5 not made of corrugated cardboard. To overcome this deficiency of Ford, the
6 Examiner turns to Zimmerman for a teaching that corrugated cardboard was
7 a known material in the shipping/packaging art. (Final Rejection 2.) The
8 Examiner additionally asserts (Final Rejection 3) that the Ford-Zimmerman
9 combination lacks or does not expressly disclose the provision of a second
10 advertisement. The Examiner (*id.*) turns to Jenniches for a teaching of
11 providing the carton of Ford-Zimmerman with a second advertisement for a
12 second product of a second party separate and distinct from said first party.
13 The Examiner adds that it would have been obvious to print the
14 advertisements simultaneously in order to reduce the number of
15 manufacturing steps.

16 Appellant contends (Br. 13) that Ford does not disclose a
17 shipping/packing carton, nor a shipping/packaging carton as alleged by the
18 Examiner. Appellant additionally contends that Ford does not disclose a
19 shipping/packaging carton having an advertisement printed on the outer
20 carton surface, because Ford does not disclose an advertisement (Br. 13-14).
21 Appellant additionally contends that it would not have been obvious to form
22 the carton of Ford from corrugated cardboard in order to improve container
23 wall strength. Appellant additionally argues (Br. 15) that the combination
24 of Ford and Zimmerman fails to disclose, either expressly or impliedly, a
25 first advertisement and a second advertisement.

1 Appellant further contends that Jenniches does not teach a
2 shipping/packaging carton but rather teaches a pack of cigarettes. Moreover,
3 Appellant contends (Br. 17) that none of the cited references are directed to
4 a shipping carton that advertises the products of the owner or sender of the
5 carton, as well as the products of another party.

6 Turning to claim 11, the Examiner's position (Final Rejection 4) is
7 that "the carton of Ford-Zimmerman-Jenniches discloses the claimed
8 invention by presentation." The Examiner explains (Answer 8) that

9 [A]ppellant questions the rejection based upon presentation. It
10 is respectfully asserted that the method of claim 1 is directed to
11 the provision of a final product. As such, when the method is
12 performed, it results in a final product or article. Accordingly,
13 when the method of Ford-Zimmerman-Jenniches is performed,
14 the article of claim 11 is met by presentation of the finished
15 method.

16
17 With respect to the rejection of claim 11 under 35 U.S.C. § 103(a) as
18 being unpatentable over Kapp in view of Zimmerman, the Examiner
19 contends (Final Rejection 4-5) that in view of Zimmerman's disclosure of
20 using corrugated cardboard material in the shipping/packaging art, it would
21 have been obvious to form the carton of Kapp from corrugated cardboard to
22 improve the container wall strength. The Examiner adds (Final Rejection 5)
23 that the printed matter in the claim is not functionally related to the substrate
24 and does not distinguish from the prior art. Appellant contends (Br. 19) that
25 Kapp does not disclose a shipping/packaging container, and that it would not
26 have been obvious to form the box of Kapp of corrugated cardboard because
27 Kapp's box is made of thin cardboard or reinforced paper. Appellant opines
28 that since card 22 is detachable from the remainder of the box, it would be

1 contrary to the teachings of Kapp to reinforce the Kapp box with corrugated
2 cardboard.

3 ISSUES

4 With respect to the rejection of claims 1 and 11 under 35 U.S.C.
5 § 103(a) as being unpatentable over Ford in view of Zimmerman and
6 Jenniches, the issue is whether the combined teachings and suggestions of
7 the prior art would have suggested all of the limitations of claims 1 and 11.

8 With regard to the rejection of claim 11 under 35 U.S.C. § 103(a) as
9 being unpatentable over Kapp in view of Zimmerman, the issue is whether
10 the combined teachings and suggestions of the prior art would have
11 suggested all of the limitations of claim 11.

12
13 FINDINGS OF FACT

14 We find that the following enumerated findings are supported by at
15 least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d
16 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general
17 evidentiary standard for proceedings before the Office).

18 1. Appellant invented a method of advertising and a
19 shipping/packaging container product. (Specification 3.)

20 2. The method includes (*id.*) the steps of
21 providing a shipping/packaging container product, such as a
22 carton; providing on a first predetermined area of said
23 shipping/packaging container product a first advertisement of a
24 first party owning said shipping/packaging container product;
25 and providing on a second predetermined area of said
26 shipping/packaging container product a second advertisement
27 of a second party separate and distinct from said first party.

1 The limitations regarding the carton of claim 11 substantially
2 parallels the language found in the method steps of claim 1.

3 From our review of *Ford*, we make the following findings of fact:

4 3. This invention pertains to boxes or cartons designed
5 primarily to hold and enclose a plurality of units of
6 merchandise of a fixed size and character, and from which one
7 or more units may be removed, from time to time. (Col. 1, ll.
8 1-5.)

9

10 4. The main object of the invention is to provide as a portion
11 of the carton, an element which may be brought into masking
12 position with reference to a numeral appearing on the carton
13 indicating the number of units initially packed in the carton, and
14 at the same time to present a surface upon which may be placed
15 a numeral indicating the number of units remaining within the
16 carton after removal of one or more of such units. (Col. 1, ll.
17 8-16.)

18

19 5. [I]t may be said that all boxes are shipped from the factory.
20 (Col. 1, ll. 18-19.)

21

22 6. Hence, it is generally the custom to pack the higher number
23 of rings in each box or carton and for the salesman or jobber to
24 remove the desired number, close the box and return it with the
25 remaining rings to the shelf, the box still showing the original
26 index number, say "12". (Col. 1, ll. 33-39.)

27

28 7. The box . . . ha[s] a surface upon which may be written, if
29 desired, the number of rings remaining in the box. (Col. 1, ll.
30 42-48.)

31

32 8. [T]he carton is made up in the instant case from a single
33 piece of cardboard. (Col. 2, ll. 25-26.)

34

1 9. The box in the drawing is designed to have packed therein
2 say "12" piston rings of a given size, for instance, $3^{1/4} + .010^{1/8}$ -
3 Compression. (Col. 2, ll. 32-34.)

4
5 From our review of *Zimmerman*, we make the following findings of
6 fact:

7 10. This invention relates generally to packages. More
8 particularly [the] invention relates to an improved construction
9 for shipping or mailing boxes, cases or packages specifically
10 adapted to carry an envelope or letter along with the shipment
11 of goods. (Pg. 1, Col. 1, ll. 1-6.)

12
13 11. The walls of the carton **10** may be made of the standard
14 type of construction comprising an inner corrugated cardboard
15 member **20** to which there is adhesively attached an inner sheet
16 of cardboard material **21** and an outer sheet of cardboard
17 material **22**. (Pg. 1, Col. 2, ll. 22-27.)

18
19 12. [The] invention may be satisfactorily worked out in
20 connection with any type of carton, made from any suitable
21 type of material comprising layers or sheets adhesively joined.
22 (Pg. 2, Col. 1, ll. 12-16.)

23
24 From our review of *Jenniches*, we make the following findings of
25 fact:

26
27 13. The cigarette packet usable for all makes, carries
28 advertisements from a source other than the manufacturer on
29 the narrow sides. (Basic Abstract. ¶ 1.)

30
31 14. The system enables the manufacturer to reduce his costs by
32 providing publicity for other firms who for their part have the
33 opportunity to reach an increased number of consumers.
34 Printed matter can be applied subsequently by using the
35 adhesive labels, or can be directly printed on the packet. (Basic
Abstract, ¶ 2.)

1
2 15. CIGARETTE PACK, WHOSE BOTH NARROW SIDES
3 ARE PLACED AT THE DISPOSAL OF ADVERTISERS OF
4 OTHER BRANCHES [OF TRADE, INDUSTRY, BUSINESS
5 etc] (Translation, p. 1 Title) (All text and emphasis original.)
6

7 16. The cigarette packs are characterized in that the imprint or
8 stamp of an advertiser from another branch [of trade, business,
9 industry, services, etc] appears on the narrow sides.
10 (Translation, p. 1 ¶ 2) (All text original.)
11

12 17. Purpose: In the case of these cigarettes packs [boxes], both
13 narrow sides are not imprinted – as until recently- with the
14 imprint or stamp of the cigarette-maker but are kept free for
15 advertisement imprints of other advertiser, in order to be able to
16 place therein their advertisements. (Translation, p. 2 ¶ 3) (All
17 text original.)
18

19 18. [T]he cigarette manufacturer significantly increases its
20 profit by making available the advertisement space for fees or
21 remuneration. (Translation, p. 3, ll. 3-5.)
22

23 From our review of *Kapp*, we make the following findings of fact:

24 19. Towards this goal, cereal boxes, for example, often include
25 cut-out cards or other associated paraphernalia which are
26 desired by children. (Col. 1, ll. 24-27.)
27

28 20. Both sides of the collectible card contain indicia, with one
29 side of the card preferably depicting an illustration and an
30 opposite side of the card including a description of the
31 illustration and other information associated with the
32 illustration and with respect to a numbering of a particular
33 series of collectible cards. (Col. 1, ll. 46-50.)
34
35
36
37

21. [P]referably, the box is made of thin cardboard or reinforced paper. (Col. 2, ll. 35-36.)

22. The other exposed surfaces of the box includes advertising indicia to urge the consumer to buy the contained product with the additional benefit of having a collectible card storable within the empty box. (Col. 3, ll. 3-6.)

23. It is an object of the present invention to induce purchasers of a product contained in a box. (Col. 1, ll. 34-35.)

PRINCIPLES OF LAW

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *In re Kahn*, 441 F.3d 977, 985, 78 USPQ2d 1329, 1334 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 13-14, 148 USPQ 459, 464-65 (1966)). In *Graham*, the Court held that that the obviousness analysis begins with several basic factual inquiries: “[1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17, 148 USPQ at 467. After ascertaining these facts, the obviousness of the invention is then determined “against th[e] background” of the *Graham* factors. *Id.* at 17-18, 148 USPQ at 467.

The Federal Circuit has repeatedly recognized that to establish a prima facie case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. See e.g., *Kahn*, 441 F.3d at

1 987-88, 78 USPQ2d at 1336 (“the teaching, motivation, or suggestion may
2 be implicit from the prior art as a whole, rather than expressly stated in the
3 references”); and *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502
4 (Fed. Cir. 1988) (“for the purpose of combining references, those references
5 need not explicitly suggest combining teachings”). The court recently noted,

6 An explicit teaching that identifies and selects elements from
7 different sources and states that they should be combined in the
8 same way as in the invention at issue, is rarely found in the
9 prior art. As precedent illustrates, many factors are relevant to
10 the motivation-to-combine aspect of the obviousness inquiry,
11 such as the field of the specific invention, the subject matter of
12 the references, the extent to which they are in the same or
13 related fields of technology, the nature of the advance made by
14 the applicant, and the maturity and congestion of the field.

15 *In re Johnston*, 435 F.3d 1381, 1385, 77 USPQ2d 1788, 1790 (Fed. Cir.
16 2006).

17 The Supreme Court has provided guidelines for determining obviousness
18 based on the Graham factors. *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 82
19 USPQ2d 1385 (2007). “A combination of familiar elements according to
20 known methods is likely to be obvious when it does no more than yield
21 predictable results.” *Id.* at 1731, 82 USPQ2d at 1396. “When a work is
22 available in one field of endeavor, design incentives and other market forces
23 can prompt variations of it, either in the same field or a different one. If a
24 person of ordinary skill can implement a predictable variation, §103 likely
25 bars its patentability.” *Id.* For the same reason, “if a technique has been
26 used to improve one device, and a person of ordinary skill in the art would
27 recognize that it would improve similar devices in the same way, using the
28 technique is obvious unless its actual application is beyond that person’s

1 skill." *Id.* at 1740, 82 USPQ2d 1396. "Under the correct analysis, any need
2 or problem known in the field of endeavor at the time of invention and
3 addressed by the patent can provide a reason for combining the elements in
4 the manner claimed." *Id.* at 1742, 82 USPQ2d at 1397.

5 ANALYSIS

6 From the description of Ford (fact 5) that the boxes are shipped from
7 the factory with the number of rings and the size thereof shown on one face
8 of the box, we find that the product is shipped in the box and not put into
9 another container for shipping as advanced by Appellant (Reply Br. 5). We
10 find Appellant's assertion (*id.*) that "common sense also dictates that one
11 would not ship the piston rings in the same box without an outer or larger
12 container" to be unsupported by any convincing evidence in the record. In
13 any event, even if the box of Ford was placed into another box for shipping,
14 the product is still shipped in box 1.

15 In addition, from the description of Ford (facts 5-6) that the box or
16 carton that holds the rings is shipped, we find that the box or carton 1 of
17 Ford is a shipping/packaging carton.

18 Moreover, from the description of Ford (fact 8) that the box or carton
19 is made from a single piece of cardboard, and the description of Zimmerman
20 (facts 10 and 11) that the shipping or mailing container can be made from
21 any type of any standard type of construction comprising corrugated
22 cardboard, we find that an artisan would have been motivated to make the
23 cardboard box of Ford from corrugated cardboard.

24 Additionally, from the description of Jenniches (fact 13) that the
25 cigarette package carries advertisements from a source other than the

1 manufacturer on the narrow sides, we find that the manufacturer will
2 advertise the product on the front of the package and leave the sides of the
3 product for advertisements from other manufacturers. From the description
4 of having the manufacturer's advertisement on one portion of the package
5 and the advertisement of another manufacturer on another predetermined
6 area of the package, we find that an artisan would have been motivated to
7 place advertisements of the manufacturer of the rings and other
8 manufacturers on the package of Ford.

9 We are not persuaded by Appellant's assertion (Br. 13-14 and Reply
10 Br. 2) that Ford does not disclose an advertisement on an outer surface of the
11 carton. As illustrated in Fig. 1 of Ford, and as found in fact 9, the box
12 illustrates the number, size, and type of rings in the box. As noted by the
13 Examiner (Answer 5) Ford indicates (p. 1, ll. 17-25) that when stacked on
14 the shelf, the descriptive matter on the box is exposed. From the description
15 in Ford that the descriptive matter is exposed, and the description (fact 6)
16 that when rings are removed, the number of remaining rings is displayed on
17 the box, we find that the descriptive matter in the box is an advertisement to
18 customers of how many rings are in the box and for sale. In any event, as
19 we found, *supra*, Jenniches suggests having an advertisement from a
20 manufacturer on one portion of the carton and an advertisement from
21 another manufacturer on another portion of the carton.

22 Nor are we persuaded by Appellant's contention (Br. 15) that the
23 combination of Ford and Zimmerman fails to disclose a first advertisement
24 and a second advertisement because Jenniches suggests the first and second
25 advertisements from different manufacturers.

1 Nor are we persuaded by Appellant's contention (Br. 17 and Reply Br.
2 6) that Jenniches does not teach a shipping/packaging carton but rather
3 teaches a pack of cigarettes. Firstly, Ford teaches the use of a
4 shipping/packaging carton. Secondly, Jenniches teaches a cigarette packet
5 which is a package for the cigarettes. The cigarette package, usually in the
6 form of a box, is a carton for the cigarettes. Because the carton is capable of
7 being shipped, either alone, or in a larger package, it is a shipping/packaging
8 carton. We find nothing in the record that would preclude a carton placed
9 inside a larger carton or container for shipping from being considered to be a
10 shipping carton.

11 Nor are we persuaded by Appellant's contention (Br. 17) that none of
12 the references are directed to a shipping/packaging carton that advertises the
13 products of the owner or sender, as well as the products of another party. As
14 we found, *supra*, Ford describes a shipping/packaging carton, and Jenniches
15 describes a package having advertisements from both the product
16 manufacturer and another manufacturer.

17 Nor are we persuaded by Appellant's contention (Br. 17) that "[i]f the
18 claim 1 invention were in fact obvious, those skilled in the art would have
19 implemented it by now." Appellant's contention blurs the distinction
20 between § 102 and § 103 because Appellant is in effect arguing that since
21 the invention is not anticipated, it is therefore non-obvious. See, *Tokyo*
22 *Shiabura Elec. Co., Ltd. v. Zenith Radio Corp.*, 548 F.2d 88, 95, n. 21, 193
23 USPQ 73, 80, n. 21 (3rd Cir. 1977).

24 Nor are we persuaded by Appellant's assertion (Br. 18) that claim 1
25 solves and is directed to a different problem than that of the cited references.

1 Appellant directs us to *In re Wright*, 848 F.2d 1216, 6 USPQ2d 1959 (Fed.
2 Cir. 1988), in support of Appellant's position. In *In re Dillon*, 919 F.2d 688,
3 693-94, 16 USPQ2d 1897, 1902 (Fed. Cir. 1990), the court, in an *in banc*
4 decision, overruled the holding in *In re Wright*, relied upon by Appellant.
5 Appellant [Dillon] cited *In re Wright*, 848 F.2d at 1219, 6 USPQ2d at 1961,
6 for the proposition that a *prima facie* case of obviousness requires that the
7 prior art suggest the claimed compositions' properties and the problem the
8 applicant attempts to solve. *Dillon*, 919 F.2d at 692-93, 16 USPQ2d at 1901.
9 Appellant Dillon asserted that none of the references relates to the problem
10 she confronted, *Dillon*, 919 F.2d at 693-94, 16 USPQ2d at 1902. The court
11 stated that:

12 it is not necessary in order to establish a *prima facie* case of
13 obviousness that both a structural similarity between a claimed and
14 prior art compound (or a key component of a composition) be shown
15 and that there be a suggestion in or expectation from *the prior art* that
16 the claimed compound or composition will have the same or a similar
17 utility *as one newly discovered by applicant*. To the extent that
18 *Wright* suggests or holds to the contrary, it is hereby *overruled*.
19

20 *Dillon*, 919 F.2d at 692-93, 16 USPQ2d at 1901.

21 The Supreme Court's statement in KSR that "The first error of the
22 Court of Appeals in this case was to foreclose this reasoning by holding that
23 courts and patent examiners should look only to the problem the patentee
24 was trying to solve. 119 Fed. Appx., at 288. The Court of Appeals failed to
25 recognize that the problem motivating the patentee may be only one of many
26 addressed by the patent's subject matter. The question is not whether the
27 combination was obvious to the patentee but whether the combination was
28 obvious to a person with ordinary skill in the art. Under the correct

1 analysis, any need or problem known in the field of endeavor at the time of
2 invention and addressed by the patent can provide a reason for combining
3 the elements in the manner claimed." 127 S.Ct. 1727, 1742.

4

5 Nor are we persuaded by Appellant's assertion (Br. 18) that the cited
6 references are from different fields than that of the claim 1 invention, and
7 this factor weighs against their use in a rejection. The test for analogous art
8 is that the references are either in the same field of invention, or that they are
9 reasonably related to the problem that Appellant is seeking to overcome.
10 Here, we find that Jenniches is directed to a package having two sets of
11 advertisements, one from the manufacturer of the product, and the other
12 from another manufacturer. The problem of increasing advertising revenue
13 by setting aside a portion of a package for advertising by another
14 manufacturer is the same problem that Appellant is solving.

15 Nor are we persuaded by Appellant's contention (*id.*) that "the fact
16 that the last OA resorts to three prior art references in an effort to allege the
17 unpatentability of claim 1, is an indication in and of itself that the claim 1
18 invention is not obvious." Appellant's argument is totally lacking in merit.
19 As correctly noted by the Examiner (Answer 8) "reliance on a large number
20 of references in a rejection does not, without more, weigh against the
21 obviousness of the claimed invention." As stated by the court in *In re*
22 *Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1889 (Fed. Cir. 1991), "[t]he
23 large number of cited references does not negate the obviousness of the
24 combination, for the prior art uses the various elements for the same
25 purposes as they are used by appellants, making the claimed invention as a

1 whole obvious in terms of 35 U.S.C. § 103.” We do not consider three
2 references to be a large number of applied references.

3 From all of the above, we hold that the combined teachings and
4 suggestions of Ford, Zimmerman, and Jenniches would have suggested to an
5 artisan the subject matter of claim 1, for the reasons advanced by the
6 Examiner and amplified by our comments, *supra*.

7 We turn next to claim 11. At the outset, we make reference to our
8 findings, *supra*, with respect to the teachings and suggestions of Ford,
9 Zimmerman, and Jenniches. We note the assertion of the Examiner (Answer
10 8) to the effect that upon carrying out the method of the applied prior art, as
11 advanced in the rejection of claim 1, the article of claim 11 results from the
12 method. Appellant asserts (Br. 18) that "the carton of Ford-Zimmerman-
13 Jenniches does not disclose the claim 11 invention based on the arguments
14 set forth above by [A]ppellant with respect to claim 1." Accordingly, we
15 hold that the combined teachings and suggestions of Ford, Zimmerman, and
16 Jenniches would have suggested to an artisan the limitations of claim 11 for
17 the same reasons as we found claim 1 to be met by the applied prior art.

18 We turn next to the rejection of claim 11 under 35 U.S.C. § 103(a) as
19 being unpatentable over Kapp in view of Zimmerman. The Examiner's
20 position can be found on pages 4-6 of the Final Rejection. From our review
21 of Kapp, we find that Kapp describes a box having a product inside (fact
22 23). We further find that Kapp describes the box as being made from
23 cardboard (fact 21). From the fact that the product is inside the box, we find
24 the box to be a package containing the product. Since the box is capable of
25 being shipped we find the box of Kapp to be a shipping/packaging carton.

1 From the description of Zimmerman that a shipping/packaging carton (fact
2 10) can be made of corrugated cardboard (fact 12), we find that an artisan
3 would have considered it obvious to have formed the box of Kapp out of
4 cardboard. In addition, we find that Kapp describes plural advertisements on
5 the exposed surfaces of the box (fact 22). Thus, we agree with the
6 Examiner (Final Rejection 5) that the claim differs from the combination of
7 Kapp and Zimmerman only by the specific arrangement and/or content of
8 the indicia (advertisements). We add that the claim also recites that the first
9 advertisement is for a product of a party owning the carton, and that the
10 second advertisement is of a second party whose product is not in the carton.
11 The claim additionally recites that both advertisements are printed on the
12 carton and that the second advertisement is in an area that would otherwise
13 be void of advertising. Moreover, the claim recites that the second
14 advertisement area is allotted by the first party, and that the first party does
15 not buy the second party's advertisement. The claim additionally recites that
16 the first party determines the size and location of the second advertisement,
17 and that the size of the second advertisement is determined, at least in part,
18 by the size of the carton.

19 From our consideration of the claim as a whole, we agree with the
20 Examiner (Final Rejection 5) that because the printed matter is not
21 functionally related to the substrate (carton), the printed matter, based upon
22 the specific facts of this case, does not patentably distinguish the claimed
23 invention from the prior art. In our view, the size, location, and ownership
24 of the advertisements would have been obvious to an artisan as predictable
25 results of familiar elements according to known methods, as advanced by the

1 Examiner. As stated by the court in *KSR Int'l v. Teleflex Inc.*, 127 S.Ct.
2 1727, 82 USPQ2d 1385 (2007) “[a] combination of familiar elements
3 according to known methods is likely to be obvious when it does no more
4 than yield predictable results. *Id.* at 1731, 82 USPQ2d at 1396.

5 We are not persuaded by Appellant's contention (Br. 23) questioning
6 why it would have been obvious to have a first party own the
7 shipping/packaging carton. If a company placed a product of their company
8 in a carton for shipping, an artisan would have been motivated to place the
9 name of the company on the carton as an advertisement. This is well known
10 to an artisan in the field of placing advertising on shipping cartons. For
11 example, if Sony Corp. placed a television in a carton for shipping to a
12 distributor or buyer, they would know to place the name Sony on the carton.

13 Nor are we persuaded by Appellant's contention (*id.*) questioning why
14 a first party would provide an advertisement from a second, distinct party.
15 It is well known in Nascar and in cycling, etc. to have multiple
16 advertisements on products. From this knowledge, an artisan would have
17 considered it obvious to place different advertisements on packages.

18 Nor are we persuaded by Appellant's contention (*id.*) questioning
19 why it would have been obvious to have a first party determine the size and
20 location of a second party's advertisement. If a first party is allowing a
21 second party to advertise their product on the first party's package, it is
22 inherent that the first party will determine how much advertising space to
23 allow the second party to have.

24 Nor are we persuaded by Appellant's contention (*id.*) questioning
25 why it would have been obvious to place an advertisement in an area that

1 would otherwise be blank. Aside from the fact that Ford teaches this feature,
2 we fail to see how placing an advertisement in an area that would otherwise
3 be blank would distinguish a claim from the prior art. An artisan would be
4 aware to place advertisements wherever desired, including both areas that
5 would have had other indicia as well as areas that would have otherwise had
6 no other indicia.

7 From all of the above, we are not convinced of any error on the part of
8 the Examiner in rejecting claim 11 under 35 U.S.C. § 103(a) as being
9 unpatentable over Kapp in view of Zimmerman.

10

11 CONCLUSION OF LAW

12 On the record before us, Appellant has failed to establish error on the
13 part of the Examiner in rejecting claims 1 and 11 under 35 U.S.C. § 103(a)
14 as being unpatentable over Ford in view of Zimmerman and Jenniches, and
15 has failed to show error on the part of the Examiner in rejecting claim 11
16 under 35 U.S.C. § 103(a) as being unpatentable over Kapp in view of
17 Zimmerman. The rejection of claim 1 and the rejections of claim 11 under
18 35 U.S.C. § 103(a) are sustained.

19

20 DECISION AND ORDER

21 The Examiner's decision to claims 1 and 11 is affirmed.

1 No time period for taking any subsequent action in connection with
2 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
3 § 1.136(a)(1)(iv) (2006).

4

5 **AFFIRMED**

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